II. STATUS OF THE CLAIMS

Claims 1-13 are claims from the original '124 patent and claims 14-37 were added in the '138 reissue application. Claims 1-37 have been cancelled, as the '138 reissue application has been abandoned. Claims 38-43 were previously presented and are now amended. Claims 44-56 are the claims originally granted in the '124 patent, cancelled when the '138 application was abandoned, and now are newly presented in this application. Claims 57-62 are claims newly presented in this application. For clarity, a listing of the claims as amended from the claims originally presented in this reissue application follows. A listing of the claims that conforms to 37 C.F.R. 1.173(d)(1)-(2) and shows the status of the claims relative to the original patent is located at Appendix B.

IV. REMARKS REGARDING CONTINUATION REISSUE APPLICATIONS

a. Double Patenting

The parent reissue application 10/113,138 has been abandoned by a letter of express abandonment received by the USPTO on February 3, 2004. The Notice of Abandonment issues by the PTO is attached as Appendix C to this Response. As the examiner noted in the Office Action, where a continuation reissue application is filed with a copy of the oath/declaration and assignee consent from the parent reissue application, and the parent reissue application is abandoned, the copy of the consent should be accepted by both OIPE and the examiner. The examiner should check to ensure that the oath/declaration identifies an error which is still being corrected in the continuing application. See MPEP 14. In this case, the oath/declaration does indeed identify an error (specifically, "patentee claiming more or less than he had the right to claim in the patent") that is still being corrected in the continuing application, and the parent reissue application has been abandoned.

b. Reference to pending applications

As mentioned above, the parent reissue application has been expressly abandoned, thus this issue is moot.

c. Oath and/or Declaration

The reissue declaration submitted with this application both positively states the error which arose without deceptive intent and states how the error renders the patent inoperative or invalid as set forth in MPEP §1414(II). A copy of the reissue declaration is attached as Appendix D. On page 1 of 2, patentee states in the declaration that "I verily believe the original patent to be wholly or partially inoperative or invalid, for the reasons described below. The box marked "by reason of the patentee claiming more or

less than he had the right to claim in the patent" is checked. This declaration is sufficient to state how the error renders the patent inoperative or invalid under MPEP §1414(II).

V. REMARKS REGARDING SURRENDER OF ORIGINAL PATENT

An examination of the merits of the reissue application can be made in the absence of the original patent or a statement as to loss or inaccessibility of the original patent. Either the original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue can be allowed. However, as the examiner has proposed other reasons for disallowance of this application, patentee respectfully requests that the examination of the merits of the reissue be made before the original patent is surrendered.

VI. REMARKS REGARDING PRELIMINARY AMENDMENT

Applicant respectfully points out that a statement as required by 37 C.F.R. 1.173(c) which specifically points out the support in the specification for the subject matter of the amendment, was submitted. In the preliminary amendment filed February 3, 2004, the following paragraph was included:

"Applicants emphasize that the present claims are directed to features heretofore not found in any in-line skate, i.e., spacers integral with the metal chassis and that are formed by countersinking metal that surrounds hole formed in the chassis for the wheel axles, and a countersunk region on the opposite side of the chassis that accommodates a flat head screw or axle. Support for these features is found, for example at 3:65-4:16."

The referred-to portion of the original specification states:

> "The spacers 115 extend inwardly relative to the sides 101 and 102. The spacers assist in the proper spacing of the skate wheels when they are assembled with the chassis.
>
> Referring now to FIG. 5, there is shown a detailed view of a spacer 115. As described supra, each spacer 115 is extruded or coined in the side 101 or 102 as appropriate. In particular, the spacer 115 takes a generally truncated conical configuration of material on the inner surface of the relative side. The spacer 115 defined to include a flat, annular surface 503 and central axial aperture 120 which has the appropriate diameter to engage and/or interact with the axle 501, which supports the skate wheel when the skate is assembled. *Typically, the spacer is, effectively, countersunk on the exterior of the respective chassis side.* The countersunk configuration can be advantageously used to accommodate a flat head screw 502 (and/or axle 501) in order to provide a smooth exterior surface for the assembled skate. Of course, carriage bolts or screws with other head configurations can be used, if desired" (emphasis added.)

This portion of the specification is ample support for the subject matter of the amendment.

VII. OFFER TO SURRENDER THE ORIGINAL PATENT

In response to the requirement made to surrender the original '124 patent, Applicants state that, upon Notice of Allowability of any pending claim herein, Applicants will surrender the original 6,042,124 patent or provide a statement that the original patent has been lost.

VIII. REPLY TO REJECTIONS MADE (AND PROSPECTIVELY MADE TO THE NEW CLAIMS) UNDER THE RECAPTURE ESTOPPEL RULE

The proper focus during a reissue proceeding is on the scope of the claims, not on the individual feature or element purportedly given up during prosecution of the original application. *Ball Corp. v. United States*, 729 F.2d 1429, 1437 (Fed. Cir. 1984). If the reissue claims are narrower than the canceled claims, yet broader than the original patent claims, reissue must be sought within 2 years after grant of the original patent. *Id.* Broadening reissue is proper here because the parent reissue application was filed within 2 years of the grant of the original patent.

In general, the following principles apply: (1) if the reissue claim is as broad as or broader than the canceled or amended claim in all aspects, the recapture rule bars the claim; (2) if it is narrower in all aspects, the recapture rule does not apply, but other rejections are possible; (3) if the reissue claim is broader in some aspects, but narrower than others, then: (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; (b) if the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible. *In Re Clement*, 131 F.3d 1464, 1470 (Fed. Cir. 1997). In this case, the reissue claims are not broader than the cancelled claim in all aspects, nor are they narrower in all aspects. In this case, the reissue claim is narrower in an aspect germane to the prior art rejection and broader in an aspect unrelated to the rejection *because this broader coverage was never sought in the original prosecution and as such, was never surrendered*, and thus the recapture rule does not bar the claim, though other rejections are of course possible.

The first presented claims were directed towards a one piece skate chassis, and broader coverage of a multi-piece skate chassis was never requested, and thus never rejected. Because this element appeared in the first presented claims of the application before they had even initially been examined, it was not specifically added to overcome a rejection or to provide a more clearly defined claim. While this element of the previously

claimed invention may have been pointed out in conjunction with other elements to facilitate the allowance of claimed elements that are not claimed here, the one piece limitation itself was never itself added to overcome a rejection, as it was always present in the claims previously allowed claims.

With respect to the coining limitation, the claims previously presented are in fact narrower than the claims that were amended in order to be allowed. Countersinking or counterpressing is a machining or coining operation to generate a conical angle or recessed area on a hole, clearly a narrower limitation than simply coining. For a verification of this definition of countersinking, please see Appendix E. This more specific limitation is not an improper recapture of broadened subject matter.

With respect to the limitation that the spacer elements surround an aperture through which an axle is positioned, Claims 41 and 42 do mention that the countersunk configurations are adapted to accommodate a screw or axle. The remarks regarding amendments that the examiner refers to state merely: "[S]pacers, also referred to as projections, are later formed in that part of the single metal that surrounds the apertures through which the wheel axles pass." (Emphasis in original). The amendment was geared towards pointing out the timing of the formation of the projections, and not what may or may not pass through the projections. Thus, the claims were not narrowed in this manner in order to overcome a rejection.

Here, as in Doyle, all of the relevant claims at issue with respect to a recapture estoppel argument are new claims – not amendments to issued claims. In re Doyle at 1357. Additionally, as in Doyle, there is at least one term in the new claims that provides for a broader scope of protection than was ever sought in the original prosecution. Here, as in Doyle, the applicant never asserted the reissue claims or anything similar to them in his original application, and also never agreed to prosecute the reissue claims in a divisional application.

IX. REPLY TO REJECTIONS MADE UNDER 35 U.S.C. § 112

Claims 40-42 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 41 and 42 have been amended to remove the limitation that the spacers be made at a "convenient" time in the process, thus defining the limitations associated with the term "convenient" is unnecessary. Claim 40 has also been amended in order to clarify that this claim is an apparatus claim without method limitations. It is not believed that the changes made in any way limit or restrict the claims as previously presented.

X. REPLY TO REJECTIONS MADE (AND PROSPECTIVELY MADE TO NEW CLAIMS) UNDER 35 U.S.C. § 103

A. Rejections Prospectively Made to New Claims under 35 U.S.C. § 103

The claims that are labeled as "new" are the claims that were originally granted in the '124 patent. During the prosecution of the now abandoned parent reissue application, these original claims were rejected under 35 U.S.C. 103(a) as being unpatentable over Benoit (U.S. 6,301,771, filed 10/1996), either standing alone as a reference or in conjunction with Rudolph (U.S. 6,047,972 filed 11/1997, 7/1996) or Miller (U.S. 2,533,277). It is expected that the examiner will have the same objections to the claims now as he expressed in the previous application, hence for the sake of completeness, clarity and efficiency, the points he made in that application will be addressed here, though these claims are new with respect to this application.

There are significant differences known to those in the art between general "closed die forging" and "coining." According to the Forging Industry Association, closed die forging, a form of impression die forging, does not depend on flash formation to achieve complete filling of the die. Rather, in closed die forging, material is deformed in a cavity that allows little or no escape of excess material, thus placing greater demands on die design. Coining and ironing, on the other hand, are essentially sizing operations with pressure applied to critical surfaces to improve tolerances, smoothen surfaces, or eliminate draft. Coining is usually done on surfaces parallel to the parting line. Little metal flow is involved in either operation and flash is not formed. The two techniques are also distinguished because closed die forging is considered an initial type of deformation, while coining is further metalworking that forged parts undergo after being initially deformed. A copy of the Forging Industry Association reference can be found at Appendix F. The pertinent portion of the Benoit reference states: "Each hole 6 is made in a cylindrical boss 7 that can be obtained by die forging." U.S. Patent 6,301,771 at 3:32-33. Further, at 4:42-47, Benoit states:

> "With respect to an aluminum chassis made of an alloy made by injection during molding, such a manufacturing technique by pressing, and possibly by die

forging, bending, is much more precise, does not require any subsequent machining, and makes it possible to have a greater selection of material, with more interesting characteristics. Indeed, the number of available materials for injection or molding is very limited, and these materials are generally brittle and do not promote the formation of fibers.

Moreover, since the molding and injection techniques are not sufficiently precise, time-consuming and expensive additional machining would be necessary to provide the holes for attaching the gliding member(s), for example."

This effectively teaches away from coining, as coining is generally considered to be an additional machining process as it involves pressure applied to critical surfaces, here, specifically to improve tolerances. This is especially true as coining is the method for providing the countersunk or counterpressed holes and spacers for attaching the gliding member, and the Benoit reference specifically teaches away from using additional machining to provide the holes.

B. Rejections Made to Previously Presented Claims under 35 U.S.C. § 103(a)

The spacers taught by Benoit are cylindrical bosses, and do not include or involve countersunks or counterpresses. Every previously presented claim in the present application requires that the spacers be formed when areas are countersunk or counterpressed by coining.

As regards claim 42, it is true that the reference to Benoit fails to teach the formation of holes, followed by the formation of the spacers. However Hilgarth does not teach the provision of a countersink or counterpress on a skate frame side, as is presently claimed, rather Hilgarth teaches only a reinforcement, not a countersink or counterpress. It does not teach that the head of the screw or bolt lies flat with the surface of the reinforcement, but instead teaches that this reinforcement is there to "protect the head of the pin" thereby indicating that the reinforcement extends beyond the head of the pin and thus in fact teaching away from an actual countersink.

XI. CONCLUSION

For all of the reasons stated above, it is believed that every claim presented is now in a condition to be allowed. Additionally, the "new" claims are also in a condition for allowance.

Respectfully submitted,
GOLDSTEIN & FAUCETT, L.L.P.

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By: _____
Edward W. Goldstein
Reg. No. 22,945

Goldstein & Faucett, L.L.P.
1177 West Loop South
Suite 400
Houston, TX 77027
Telephone: (713) 877-1515
Facsimile: (713) 877-1737